

### REMARKS

Claims 1-50 are pending. No claims have been added, cancelled, or amended. Applicant notes with appreciation the Office's withdrawal of the §112 rejection of claim 50.

5           This Amendment B is being submitted in conjunction with a Request for Continued Examination. Applicant has submitted a credit card payment form for the amount of \$840.00, which includes the small entity fee for a three-month extension of time (\$465.00) and the fee for a Request for Continued Examination (\$375.00). It is not believed that any other fees are necessary at this time. However, in the event fees are required, Applicant authorizes the  
10   Commissioner to take any necessary fees, including those under 37 CFR 1.16 and 1.17, from deposit account 50-0913.

#### **I.     Rejection Under 35 U.S.C. §103(a)**

          Claims 1-50 have been rejected under 35 U.S.C. §103(a) over at least U.S. Patent number  
15   5,911,418 to Adams (hereinafter, "Adams") in view of U.S. Patent number 5,913,726 to Jones et al. (hereinafter, "Jones"). Applicant respectfully submits that the combination of Adams and Jones does not enable Applicant's invention, and therefore cannot render obvious Applicant's invention. Therefore, claims 1-50 are allowable. Before discussing Adams and Jones, it may be helpful to briefly review Applicant's invention.

A Brief Review of Applicant's Invention

In at least one embodiment, Applicant's invention is directed to a primary game of chance, such as a table game (e.g. blackjack, poker, and the like) or mechanical devices (such as slot machines), having a random or substantially random outcome. *See* pp. 18-19 and 26-28.

5 Certain outcomes will result in the player being qualified for play on a bonus game having various prizes. One prize in the bonus game may be a progressive, incrementing jackpot. The prizes in the bonus game are randomly awarded.

Applicant's invention combines multiple elements to create a unique game that may create significant player interest and excitement. For example, bonus games are often included  
10 in games of chance in order to create player excitement and interest. Once the player has qualified for a bonus round, they know they may receive an additional, perhaps significant, prize. However, they do not know exactly what the outcome of the bonus game will be. Therefore, players will be both excited about the prize they may receive and eagerly anticipate the outcome of the bonus game.

15 Progressive jackpots are often used to create player excitement and encourage game play. Progressive jackpots typically take a certain percentage of qualifying wagers and add them to an incrementing jackpot. The jackpot grows the more players play the associated gaming devices. The larger the jackpot, the more anticipation players feel, the more excited they become, and the more likely they are to play gaming devices that may qualify for the progressive jackpot.

20 Game designers typically try to create games that will attract and retain players in order to maximize profits for gaming proprietors. Despite the individual advantages of bonus games

and progressive prizes, until Applicant's present invention, no one had found a way to successfully combine a primary game with a bonus game having a progressive prize.

At least three factors must be taken into account and appropriately dealt with in order to obtain a game that may be used as a commercial product. Such a task is non-trivial because of  
5 regulatory considerations, player expectations of the payback percentage (the amount of wagers that is returned to players in the form of prizes or payouts) of table games or mechanical games, and the hold percentage of the casino (that is, the amount of each wager that the gaming operator may keep as profit).

In order to create a game that meets regulatory, player, and operator expectations, at least  
10 three problems must be solved. First, the probability of the bonus qualifying event occurring in the primary game must be determined, along with odds of winning all other prizes in the primary game. Second, the probability of the bonus event selecting the progressive prize must be determined, along with the odds of winning all other prizes in the bonus round. Finally, the amount of the progressive jackpot at the time the progressive jackpot is awarded must be  
15 determined. Once the target amount of the progressive jackpot is set, the starting amount, the maximum amount, the contribution rate (the amount of each wager set aside for the progressive jackpot), and the increment rate of the progressive jackpot must be set. Only when all of these variables have been optimized to obtain the desired hold and payback percentages, in addition to complying with regulatory requirements, can a commercial product be obtained. Until  
20 Applicant, no one had successfully solved this problem. Furthermore, given the interrelation of the three problems to be solved, the solution is not a simply matter of taking known bonus games and plugging in a progressive jackpot as one of the prizes and achieving a workable solution.

Rejection over Adams and Jones

Applicant and the Office have discussed Adams previously. The Office is relying on the following statement of Adams as rendering Applicant's invention obvious:

5           While the illustrated wheel indicates dollar amounts of attainable prizes, other items of value may also be utilities such as a car, a cruise, or a payout from a progressive jackpot.

Column 3, lines 63-66. Applicant has previously asserted that Adams does not enable  
10 Applicant's invention because Adams contains no other statement, teaching, or even suggestion regarding progressive prizes. Certainly Adams says nothing about the complex problem, as outlines above, of creating a successful game combining a primary game with a bonus game that randomly awards a progressive jackpot.

With respect to an enabling disclosure, while Applicant generally agrees with the Office  
15 that "size doesn't matter," this is only true if one of skill in the art would be able to make and use the Applicant's invention based only on their knowledge and the disclosure of the cited references. *See Beckman Instruments, Inc. v. LKB Produkter AB*, 892 F.2d 1547, 1551 (Fed. Cir. 1989). As has already been discussed, Adams provides no teaching regarding how to configure a progressive jackpot in a bonus game. Therefore, Applicant believes that the only other potential  
20 source of such a teaching cited by the Office must be Jones.

Jones appears to suggest a method of linking a progressive jackpot to one or more table games. *See* col. 1, lns. 48-50. It appears that, at the beginning of a game round, a player may place a side wager on a progressive jackpot. *See* col. 3, lns. 24-29. Based on the result of the table game, a **primary game**, the player may be awarded all or a percentage of the progressive

total if the player's hand matched a **set, predetermined, non-random set of outcomes**. *See* col. 3, ln. 66-col 4, ln. 3. Jones only deals with the standard, known practice of awarding a progressive jackpot as a prize in a primary game.

Jones does not in any way address how to implement a progressive jackpot as a randomly  
5 awarded prize in a bonus game associated with a primary game. Jones does not in any way elucidate the complicated mathematics of making such an arrangement possible or desirable. Therefore, the combination of Jones and Adams does not enable Applicant's invention, much less render it obvious.

Applicants note that the Office has also cited U.S. Patent number 5,280,909 to Tracy  
10 (hereinafter, "Tracy") as allegedly providing a disclosure of certain progressive jackpot related features. Tracy, similar to Jones, appears to deal with a standard progressive jackpot awarded as a prize on a primary game. In particular, Tracy appears to relate to displaying a predetermined jackpot value to players from the beginning of a game round, in order to encourage players to play for the jackpot (because they know the value of the prize they are player for). *See* col. 3,  
15 lns. 25-39. Tracy even appears to teach away from Applicants' invention, and precise selection of game parameters, by suggesting that game parameters may be "randomly" selected. *See id.* Because Tracy does not teach how to implement a progressive jackpot as a randomly awarded prize in a bonus game associated with a primary game, Tracy also may not be used to render Applicant's invention obvious.

20 Applicant further notes that the Office appears to be making some unsupported statements of what of ordinary skill in the art would be able to implement regarding progressive jackpots. To the extent this is so, Applicant respectfully requests the Office to provide an

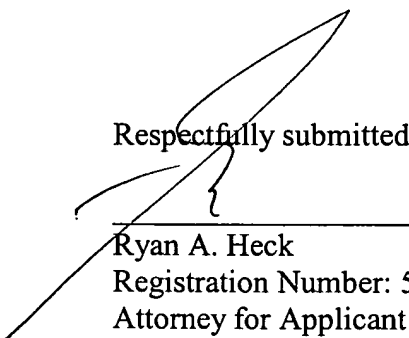
affidavit or reference to support these statements, pursuant to MPEP §2144.03. As the Applicant has already stated, to the Applicant's knowledge no one has ever made a progressive jackpot a bonus prize in a bonus game in association with a primary game. Furthermore, given the complexity of implementing such a concept, determining the parameters for awarding a progressive prize in a bonus game is not a simple extension of what is already known for standard progressive prizes.

In view of the above remarks, Applicant respectfully suggests that claims 1-50 are not obvious in view of Adams in combination with Jones. Because every rejection made by the Office relies on the combination of these two references, Applicant respectfully suggests that all claims are allowable over the cited art.

### CONCLUSION

For all of the above reasons, the Applicant submits that the present application is in condition for allowance. If the Examiner has any questions regarding the application or this Amendment B, the Examiner is encouraged to call the Applicant's attorney, Ryan A. Heck, at (775) 826-6160.

Respectfully submitted,

  
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Ryan A. Heck  
Registration Number: 51,795  
Attorney for Applicant

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